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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,082	11/13/2001	Hisato Nagase	Q67078	6582

7590 04/01/2003

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EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,082

Applicant(s)

Nagase et al.

Examiner

Bruce Hess

Group Art Unit

1774

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 1-31-02 (IDS)

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Art Unit: 1774

1. Claims 1, 3-12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Sato et al. (JP 60-089391).

Sato et al. teach a heat-sensitive recording material wherein the heat-sensitive recording layer comprises a coupler and a diazo compound of applicants' General formula (1) (i.e., when applicants' $R_{1,3}$ and $_{5-8}$ are a hydrogen atom, $R_{2,4}$ are an alkoxy group and R_9 is an alkyl group or an alkoxy group). The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine polymer glass transition temperatures, coating amounts, particle sizes and irradiating light wavelengths) fails to render applicants' claims patentable in the absence of unexpected results.

2. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Sato et al. in view of applicants' statement of the prior art.

The teachings of Sato et al. are discussed above. Applicants acknowledge in their specification that the compounds of General formula (3) are known couplers for diazo recording. Given the generic nature of the Sato et al. coupler disclosure, substitution of one known coupler [i.e., the acknowledged prior art couplers of General formula (3)] for another known coupler (i.e., the couplers of Sato et al.) would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (703) 308-2402. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

Art Unit: 1774

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7115 for regular communications and (703) 308-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

B. Hess/mn
April 1, 2003



BRUCE H. HESS
PRIMARY EXAMINER
GROUP 1300